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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,867

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Hiroaki Sato

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07/11/2006

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

GENACK, MATTHEW W

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,867

Applicant(s)

SATO, HIROAKI

Examiner

Matthew W. Genack

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2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 26-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.*, U.S. Patent No. 6,714,799, in view of Lobo, U.S. Patent No. 7,054,658.

Regarding Claim 1, Park *et. al.* discloses a system for enabling a subscriber of a GSM network to use his SIM card, associated with his GSM account, said GSM card mounted on a CDMA terminal that the user has in his possession during his time in an area with a CDMA network, said CDMA network in communication with the user's GSM network for purposes including the verification of the user's subscriber information (Abstract, Column 2 Lines 6-12, Fig. 4). The CDMA terminal includes a SIM interface for interfacing between a controller, also located inside the CDMA terminal, and the mountable SIM card (Column 2 Lines 15-18, Column 4 Line 62 to Column 5 Line 3, Fig. 3). The CDMA terminal of the disclosed invention reads information unique to the subscriber from the SIM card, and enables said SIM card after verification has been

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received (Column 2 Lines 18-22). When a GSM subscriber inserts his SIM card into a CDMA terminal of the disclosed invention, an initialization procedure is started, wherein the controller detects the insertion of the SIM card, then prompts the user for a password, and (if the correct password is inputted) then reads a first set of information from the SIM card and transmits said set of information to the CDMA network (Column 6 Lines 17-45, Fig. 5). A second set of information, comprising information relating to the identity of the GSM subscriber, is sent back from the CDMA network (after interfacing with the GSM network) to the CDMA terminal's interface, and the CDMA terminal is enabled if the GSM user is verified, said verification being based on a comparison of the two sets of information, and said CDMA terminal enablement procedure being inherent to a table in the CDMA terminal's memory wherein basic telephone functions are stored (Column 6 Line 17 to Column 7 Line 25, Column 7 Lines 46-65, Figs. 2 and 5-6).

Park *et. al.* does not expressly disclose a mobile communication device having a table storing one or more call handling procedures, said call handling procedures based on a comparison of information stored in the mobile communication device and information transmitted to said mobile communication device, for each of a plurality of networks that said mobile communication device may find itself in.

Lobo discloses a method for defining a pulse function shape for data to be transmitted in a wireless communication system (Abstract, Column 1 Lines 57-64). This method may be used with a dual mode GSM/CDMA transmitter having lookup tables (which may be considered components of a larger table), one defining pulse shapes for GSM operation and the other defining pulse shapes for CDMA operation (Column 10

Lines 31-52, Fig. 4), which allows the transmitter to operate in a system of whichever type (CDMA or GSM) it finds itself in (Column 10 Lines 27-30). The lookup data tables of the invention contain data for supporting voice and data applications (Column 10 Lines 1-23).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by including a lookup table in the mobile device memory that enables the mobile device to perform call handling operations in a plurality of networks.

One of ordinary skill in the art would have been motivated to make this modification in order to provide greater flexibility to the mobile device user (Lobo: Column 10 Lines 27-30).

Regarding Claim 2, Park *et. al.* discloses that both sets of information (traveling in opposite directions) comprise country code information (Column 6 Lines 33-42, Column 7 Lines 20-25, Figs. 5-6).

Regarding Claim 3, neither Park *et. al.* nor Lobo expressly disclose a memory that is a removably connected integrated circuit.

Examiner took official notice in a previous Office Action that the use of integrated circuits in cellular telephone memories is well known in the art. Further, any integrated circuit is removably connected to the system in which it is used because it may be unsoldered and removed as needed. Applicant's lack of traverse to the officially noted fact is taken as an admission of the facts noticed.

Thus, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to use an integrated circuit in the memory 34 (see Fig. 3) of the CDMA terminal. The modification is obvious since the use of integrated circuit chips is the current trend in the telecommunications industry.

Regarding Claim 26, *Park et. al.* discloses that the set of information transmitted to the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33-42, Fig. 5); the operation of enablement allows the user to make calls or to receive calls from one or more telephone numbers that may be stored in the CDMA terminal's memory (Column 10 Lines 60-65, Fig. 3).

Regarding Claim 29, *Park et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code and home network code information associated with the user's CDMA terminal-mounted SIM card (Column 6 Lines 33-42, Fig. 5).

4. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Park et. al.* in view of *Blood et. al.*, U.S. Patent No. 6,456,706.

Claim 31 differs substantively from Claim 1 in that the former Claim recites a time period for permitting the operation, said operation pertaining to the handling of an incoming call.

Park *et. al.* does not expressly disclose a mobile communication device having a table storing one or more incoming call handling operations, said incoming call operation(s) occurring only during a permitted time period specified in memory.

Blood *et. al.* discloses a user programmable device that screens incoming telephone calls, and either causes an incoming telephone call to be diverted without the telephone ringing, or does not cause the telephone call to be diverted and allows the telephone to ring (Abstract, Fig. 1). This device is connected to the user's telephone (Column 3 Lines 39-40, Figs. 2-3). The incoming call operation may be based on the telephone number associated with the incoming call (a comparison being made between this number and numbers programmed by the user into memory) and the time when the incoming call is received (Abstract, Column 2 Lines 37-40, Column 6 Lines 32-33, Column 8 Line 5-14, Column 8 Line 60 to Column 9 Line 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by including a table in memory for storing incoming call handling operations to be performed by the mobile device based on the time when said incoming call is received.

One of ordinary skill in the art would have been motivated to make this modification in order to filter out telephone calls that are unwanted at a particular time (Blood *et. al.*: Column 1 Lines 31-51, Column 2 Lines 15-34).

Regarding Claim 32, in the invention of Park *et. al.*, during the enabled state of operation, the CDMA terminal with mounted SIM card may receive an incoming call, as outlined above.

Regarding Claim 33, Park *et. al.* discloses that the set of information transmitted from the SIM card mounted on the CDMA terminal comprises country code information associated with the network of the user's CDMA terminal-mounted SIM card (Column 6 Lines 33-42, Fig. 5).

5. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Anvekar *et. al.*, U.S. Patent No. 6,684,072, further in view of Blood *et. al.*

Claim 35 differs substantively from Claim 1 in that the former Claim recites a mobile communication apparatus having a controller that determines the roaming status of said mobile communication apparatus, whereby a future incoming call handling operation for said mobile communication apparatus is based on a schedule and on said controller-determined roaming status.

Regarding Claims 35 and 37-38, Park *et. al.* does not expressly disclose a mobile communication apparatus having a controller that sets a future incoming call handling operation (in either a domestic or international context) for said mobile communication apparatus based on the roaming status determined by said controller (and displayed on said mobile communication apparatus) and on a schedule stored in the memory of said mobile communication apparatus.

Anvekar *et. al.* discloses a global prepaid roaming service (Abstract, Column 1 Lines 39-49, Fig. 1). A cellular telephone using the disclosed invention keeps track of its own roaming status (Column 5 Line 36 to Column 6 Line 18, Fig. 7).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by providing for the determination and display of roaming status (either domestic or international), for the CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of the different conditions, such as cost and quality of service, that may apply for a user when he is roaming in another network, and because roaming status may have a bearing on whether or not a user would like to accept a given call.

Neither Park *et. al.* nor Anvekar *et. al.* expressly discloses the use of a schedule to determine a future incoming call handling operation, nor the practice whereby the telephone device, and not the system, determines and executes the appropriate incoming call handling operation.

Blood *et. al.* discloses a user programmable device that screens incoming telephone calls, and either causes an incoming telephone call to be diverted without the telephone ringing, or does not cause the telephone call to be diverted and allows the telephone to ring (Abstract, Fig. 1). This device is connected to the user's telephone (Column 3 Lines 39-40, Figs. 2-3). The incoming call operation may be based on the telephone number associated with the incoming call (a comparison being made between this number and numbers programmed by the user into memory) and the time when the incoming call is received (Abstract, Column 2 Lines 37-40, Column 6 Lines 32-33, Column 8 Line 5-14, Column 8 Line 60 to Column 9 Line 6).

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At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* as modified by Anvekar *et. al.* by providing for the storage of a schedule in the telephone device's memory, said schedule being used to determine a future incoming call handling operation, and by providing the telephone device with the ability to determine and execute the appropriate incoming call handling operation.

One of ordinary skill in the art would have been motivated to make this modification in order to filter out telephone calls that are unwanted at a particular time (Blood *et. al.*: Column 1 Lines 31-51, Column 2 Lines 15-34).

Regarding Claim 36, Park *et. al.* discloses that the storage device used in the CDMA terminal is a removable SIM card associated with a GSM account (Abstract, Column 2 Lines 6-12).

6. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Lobo, further in view of Anvekar *et. al.*

Park *et. al.* discloses the presence of a display in the CDMA terminal with mounted SIM card (Fig. 3). Furthermore, Park *et. al.* discloses that both sets of information (traveling in opposite directions) comprise country code information (Column 6 Lines 33-42, Column 7 Lines 20-25, Figs. 5-6).

Neither Park *et. al.* nor Lobo expressly discloses the display of international roaming messages to indicate that a user is not in the country that his SIM card is registered in, nor the presence of caller ID features with the invention.

Anvekar *et. al.* discloses global prepaid roaming service (Abstract, Column 1 Lines 39-49, Fig. 1). A cellular telephone using the disclosed invention keeps track of its own roaming status (Column 5 Line 36 to Column 6 Line 18, Fig. 7). Furthermore, Anvekar *et. al.* discloses the use of caller ID features with the roaming service of the disclosed invention (Column 7 Lines 32-38).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* by providing for the display of roaming status and caller ID information for the CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of the different conditions, such as cost and quality of service, that may apply for a user when he is roaming in another network, and because roaming status may have a bearing on whether or not a user would like to accept a given call.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Lobo, further in view of Link, II *et. al.*, U.S. Patent No. 6,334,054, further in view of Haas *et. al.*, U.S. Patent No. 6,615,036.

Park *et. al.* does not expressly disclose that, while enabled, the CDMA terminal with mounted SIM card may do any one of the following: accept an incoming call, ignore an incoming call, forward an incoming call to a voice mail service, and recording a voice mail on the CDMA terminal with mounted SIM card.

Link, II *et. al.* discloses a wireless telephone that may accept an incoming call, reject an incoming call, and forward an incoming call to a voice mail system (Column 3 Lines 4-15, Column 7 Lines 17-28, Fig. 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* as modified by Lobo by allowing the CDMA terminal with mounted SIM card in an enabled state of operation to accept an incoming call, ignore an incoming call, and forward an incoming call to a voice mail service.

One of ordinary skill in the art would have been motivated to make this modification because if a GSM user is enabled to use his account in a CDMA region, then it is natural that he would desire to use features that he is used to in his region.

Neither Park *et. al.*, nor Lobo, nor Link, II *et. al.* expressly discloses the practice of downloading and storing voice mail messages locally.

Hass *et. al.* discloses the practice of a remote unit in a cellular system downloading and storing a voice mail message locally (Abstract, Column 1 Line 60 to Column 2 Line 5, Column 3 Lines 18-27, Fig. 1).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Park *et. al.* as modified by Lobo as modified by Link, II *et. al.* by providing for the downloading of voice mail messages by the CDMA terminal with mounted SIM card and storing said voice mail messages in CDMA terminal with mounted SIM card.

One of ordinary skill in the art would have been motivated to make this modification because of the convenience of having voice mail message stored on one's cellular telephone, available for review at any time, regardless of the availability of cellular service.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park *et. al.* in view of Blood *et. al.*, further in view of Link, II *et. al.*, further in view of Haas *et. al.*

The rejection of Claim 34 is parallel to that of Claim 30.

Response to Arguments

9. Applicant's arguments, filed 5 April 2006, with respect to the 35 U.S.C. 112 first paragraph rejection of Claim 1, have been fully considered and are persuasive. Said rejection has been withdrawn.

10. Applicant's arguments, filed 5 April 2006, with respect to the 35 U.S.C. 102(e) rejection of Claim 31 have been fully considered and are persuasive. Said rejection has been withdrawn.

11. Applicant's arguments, filed 5 April 2006, with respect to the 35 U.S.C. 103(a) rejection of Claim 35 have been fully considered and are persuasive. Said rejection has been withdrawn.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 571-272-7541. The examiner can normally be reached on FLEX.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7541.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Genack

Examiner

TC-2600, Division 2617



5 July 2006



DUC NGUYEN
PRIMARY EXAMINER